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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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FOSTER, JUSTIN B

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 11/25/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/495,013

Applicant(s)

GUPTA ET AL.

Examiner

Justin Foster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☒ Claim(s) 25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 25 is objected to because of the following informalities: Claim 25 is dependent on claim 25. Appropriate correction is required. The Examiner is assuming that this is a typo and Applicant intended claim 25 to be dependent on the immediately preceding claim 24.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 16-23, 32-39 and 41 are rejected under 35 U.S.C. 102(e) as being anticipated by Dubbels, *et al.* (6,222,634). With regard to claim 1, Dubbels discloses a method for printing one or more documents. Dubbels discloses receiving an indication from a user to retrieve and print the one or more documents without first displaying the one or more documents (column 5, lines 37-39). Dubbels further discloses issuing a request to retrieve the one or more documents from an associated one or more providers (column 5, lines 56-59). Dubbels further discloses receiving content of the one or more documents from the associated one or more providers into a

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printing module (column 6, lines 1-3). Dubbels further discloses printing the retrieved one or more documents from the printing module, without invoking an application associated with the one or more documents, or otherwise displaying the one or more documents to the user (column 6, lines 49-52).

1. With regard to claim 2, Dubbels discloses the invention as stated in claim 1. Dubbels further discloses displaying a web page on a video display for the user, the web page including an icon, which when selected by the user, provides an indication to retrieve and print the one or more other documents without redirecting the browser or otherwise displaying the one or more other documents (column 5, lines 30-33).

2. With regard to claim 3, Dubbels discloses the invention as stated in claim 2. Dubbels further discloses identifying a name and location of the one or more documents from instructions associated with the display of the icon (column 5, lines 53-55). Dubbels further discloses sending a request to the one or more providers at the identified location to download the one or more named documents (column 5, lines 56-59).

3. With regard to claims 4 and 5, Dubbels discloses the invention as stated in claim 1. Dubbels further discloses, in lines 49-52 of column 6, printing the documents using the conventional print function that is supplied with the web browser application. This inherently means populating one or more memory locations within printing module with document content because in order to print said documents using the conventional print function that is supplied with the browser application, the printing module must be sent the document content to be printed and once said document content is received, said content must be stored in one or more memory locations within the printing module. Said conventional print function also inherently

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must read the document content from printing module memory, interpret the document content and send print commands to a print engine for rendering. This is necessary since as each page is printed, the print data must be transferred from the printer memory to the print engine and rendered.

4. With regard to claim 6, Dubbels discloses the invention as stated in claim 1. Dubbels further discloses launching an instance of an application associated with the document locally, within the printing module, without displaying the application or the retrieved document(s) to the user (column 3, lines 59-67). This inherently comprises reading document content from printing module memory into the application associated with the document and sending a print command(s) from the launched application to a communicatively coupled printing device to render the document content from the application, since these are necessary steps for completing the print job.

5. With regard to claim 16, Dubbels discloses the invention as stated in claim 1. Dubbels further discloses a storage medium (Main Memory 120, figure 1) comprising a plurality of executable instructions (Application Programs 122, figure 1) which, when executed by a host processor (Processor 110, figure 1), implements a method according to claim 1.

6. With regard to claim 17, Dubbels discloses a computer system (element 100, figure 1) comprising a memory subsystem (Main Memory 120, figure 1) having stored thereon a plurality of executable instructions (Application Programs 122, figure 1) and a processor (Processor 110 of figure 1), coupled to the memory subsystem, to execute at least a subset of instructions to implement the method of claim 1.

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7. With regard to claim 18, Dubbels discloses an apparatus (element 100, figure 1) comprising an automated print function to generate and issue a request to an operatively coupled provider to download one or more requested documents to local memory (column 5, lines 56-59), to interpret documents shared within local memory (column 6, lines 1-3), and to print the documents on a coupled printing device from local memory (column 6, lines 49-52); and a controller (Processor 110, figure 1), coupled to the automated print function and responsive to a user indication received from a user interface, to selectively invoke an instance of the automated print function and print a requested document, without requiring any additional input from the user and without first displaying the requested document to the user.

8. With regard to claim 19, Dubbels discloses the invention as stated in claim 18. Said apparatus inherently resides within a user's computer system (see figure 1). Dubbels further discloses that the user interface is a web page provided by a provider (column 5, lines 30-32), the web page including an iconic selector (column 5, lines 37-39) which, when selected by a user, provides the controller with the user indication to invoke the automated print function.

9. With regard to claim 20, Dubbels discloses the invention as stated in claim 19. Dubbels further discloses, that the indication provided by the user interface includes name/identifier and location information (URL, column 5, lines 56-59) for one or more identified documents associated with the iconic selector.

10. With regard to claim 21, Dubbels discloses the invention as stated in claim 19. Dubbels further discloses that the controller provides the automated print function with the name/identifier and location information (URL, column 5, lines 56-59) to generate and issue a request to download the identified documents.

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11. With regard to claim 22, Dubbels discloses the invention as stated in claim 21. Dubbels further discloses that the automated print function formats the download request based, at least in part, on the identified location of the request documents (column 5, lines 56-59).

12. With regard to claim 23, Dubbels discloses the invention as stated in claim 21. Dubbels further discloses that the requested documents are downloaded into the local memory (column 3, lines 5-6).

13. With regard to claim 32, Dubbels discloses a storage medium (Main Memory 120, figure 1) comprising a plurality of executable instructions (Application Programs 122, figure 1) which, when executed, implement an automated print function, responsive to a user indication to print a document (column 5, lines 36-39), automatically generates and issues a request to a provider of the requested document to download the document (column 5, lines 56-59), whereupon the automated print function prints the downloaded document on an accessible printing device without first displaying the document to the user or requiring any further user interaction (column 6, lines 49-52).

14. With regard to claim 33, Dubbels discloses the invention as stated in claim 32. Dubbels further discloses that the automated print function formats the download request based, at least in part, on a name/identifier and location (URL, column 5, lines 56-59) of the requested document.

15. With regard to claim 34, Dubbels discloses the invention as stated in claim 33. Dubbels further discloses that the automated print function receives the name/identifier and location information from an iconic selector (print button, column 5, line 32) in a user interface (print applet 310, column 5, line 31).

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16. With regard to claim 35, Dubbels discloses the invention as stated in claim 34. Dubbels further discloses that the automated print function includes an interpretation agent (web page parsing and listing mechanism 340, column 6, lines 1-3) which reads and interprets the downloaded document without having to invoke an application associated with the downloaded document.

17. With regard to claim 36, Dubbels discloses the invention as stated in claim 35. Dubbels further discloses a graphical user interface (web browser application 210, figures 2 & 3), rendered on a display device (inherently necessary to view the GUI) operatively coupled to a printing device, the GUI comprising: textual content (HTML, figure 2) and an iconic selector (print button, column 5, line 32), associated with a document in an operating system of a host device (Operating System 126, figure 1), which when selected by a user provides a print function with a name/identifier and location of the associated document (column 5, lines 56-59) causing the associated document to be printed (column 6, lines 49-52) without first displaying the document to the user.

18. With regard to claim 37, Dubbels discloses the invention as stated in claim 36. Dubbels further discloses that the GUI is a web page (column 5, lines 21-28).

19. With regard to claim 38, Dubbels discloses the invention as stated in claim 36. Dubbels further discloses that the iconic selector is an one-click print iconic selector (column 5, lines 30-33).

20. With regard to claim 39, Dubbels discloses the invention as stated in claim 36. Dubbels further discloses tertiary iconic selectors (column 5, lines 37-39) which when invoked, direct the GUI to display an associated document.



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21. With regard to claim 41, Dubbels discloses an iconic selector (print button, column 5, lines 30-33), associated with a document in an operating system of a computing platform, the iconic selector comprising: a graphical portion (column 5, lines 21-28), displayed to a user via a display device (inherently necessary to display said graphical portion), and a control portion, including name/identifier and location information of the associated document (column 5, lines 56-59), wherein when selected by a user, the control portion issues a command with the name/identifier and location information invoking a remote print function to print the associated document (column 6, lines 49-52) without displaying the associated document to the user.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Herz (6,460,036). With regard to claim 7, Dubbels discloses the invention as stated in claim 1. Dubbels does not disclose storing a user profile. Herz teaches, in lines 48-53 of column 6, constructing a "target profile interest summary for each user" which is equivalent to a user profile. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the method of Dubbels to store a user profile as taught by Herz. The advantage of this modification would be to efficiently organize the distribution of information in a large scale system consisting of many users interconnected by means of a communication network.

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24. With regard to claim 8, Dubbels in view of Herz discloses the invention as stated in claim 7. Herz further discloses, in lines 30-32 of column 5, that “users’ target profile interest summaries are automatically updated on a continuing basis to reflect each user’s changing interests”. This is equivalent to updating the user profile with information regarding recently printed documents.

25. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Logan, *et al.* (5,721,827). Dubbels discloses the invention as stated in claim 8. Dubbels does not disclose subsidizing the printing step of a user based, at least in part, on some measured attribute calculated from the user profile. Logan teaches a similar method for printing documents where, in lines 53-59 of column 26, credit is given to a subscriber based on the number of advertisements viewed. This is equivalent to subsidizing the printing based on a number of advertisements printed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to subsidize the printing step of a user based on a measured attribute calculated from the user profile such as a number of advertisements printed. This would allow advertisers to be connected to appropriate customers.

26. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Herz. With regard to claim 11, Dubbels discloses the invention as stated in claim 1. Dubbels does not disclose identifying one or more advertisements for presentation to the user and printing one or more advertisements with the one or more retrieved documents. Herz teaches, in lines 20-29 of column 40, a method of identifying advertisements for presentation to the user. Herz further discloses, in lines 40-45 of column 40, displaying said advertisements to the user. This displaying of said advertisements to the user is equivalent to printing

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advertisements if printing were the chosen method of display as in Dubbels. It would have been obvious to one of ordinary skill in the art at the time the invention was made to identify one or more advertisements for presentation to the user and print one or more advertisement with the one or more retrieved documents as taught by Herz. This would allow the selection of just those advertisements that the user is most likely to be interested in.

27. With regard to claim 12, Dubbels in view of Herz discloses the invention as stated in claim 11. Herz further discloses, in lines 20-29 of column 40, choosing a subset of advertisements from a set of advertisements that are associated with a target object X retrieved by the user. Therefore, this subset is determined, at least in part, based on a genre of the documents requested by the user since target object X is inherently related to some genre.

28. With regard to claim 13, Dubbels in view of Herz discloses the invention as stated in claim 11. Herz further discloses, in lines 31-35 of column 40, selecting a subset of advertisements from a set of advertisements whose target profiles are within a threshold similarity distance of the target profile of target object X retrieved by the user. Said target profile is equivalent to the claimed user profile.

29. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels. Dubbels discloses the invention as stated in claim 1. Dubbels further discloses establishing a communication link between the printing device (computer system 100) and the providers (network), (column 4, lines 36-49). Dubbels does not disclose determining whether the printing device is communicatively coupled to the provider(s) of the requested document(s). However, it would have been obvious to one of ordinary skill in the art to perform said determination before

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establishing the communication link since it would obviously be unnecessary to establish the communication link if a connection were already established.

30. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Herz. With regard to claim 24, Dubbels discloses the invention as stated in claim 23. Dubbels does not disclose that the controller requests one or more advertisements from one or more providers associated with the requested documents to be printed with the requested documents. Herz teaches, in lines 16-20 of column 40, requesting advertisements from a provider that is related to the user's request and/or targeted to the user. This is equivalent to advertisements associated with the requested documents. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the controller to request one or more advertisements from one or more providers associated with the requested documents to be printed with the requested documents. This would allow just those advertisements that the user is most likely to be interested in to be shown to the user.

31. With regard to claim 25, Dubbels in view of Herz discloses the invention as stated in claim 24. Herz further discloses, in lines 31-35 of column 40, selecting a subset of advertisements from a set of advertisements whose target profiles are within a threshold similarity distance of the target profile of target object X retrieved by the user. Said target profile is equivalent to the claimed user profile.

32. With regard to claim 26, Dubbels in view of Herz discloses the invention as stated in claim 25. Herz further discloses, in lines 20-29 of column 40, choosing a subset of advertisements from a set of advertisements that are associated with a target object X retrieved

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by the user. Therefore, this subset is determined, at least in part, based on a genre of the documents requested by the user since target object X is inherently related to some genre.

33. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Logan. Dubbels discloses the invention as stated in claim 23. Dubbels does not disclose that the controller provides the requesting user with a product subsidy based, at least in part, on a measured attribute of the user profile. Logan teaches a similar method for printing documents where, in lines 53-59 of column 26, credit is given to a subscriber based on the number of advertisements viewed. This is equivalent to providing the requesting user with a product subsidy based, at least in part, on a number of advertisements, which is a featured document, printed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to subsidize the printing step of a user based on a measured attribute calculated from the user profile such as a number of advertisements printed. This would allow advertisers to be connected to appropriate customers.

34. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Herz. Dubbels discloses the invention as stated in claim 28. Dubbels does not disclose that the controller generates commands instructing the coupled printing device to print a product coupon. Herz teaches, in lines 43-47, system of delivering articles to a user that the user can then print. Herz further teaches, in lines 13-14 of column 60, that coupons can be delivered to the user instead of news articles in this system. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the controller of Dubbels to generate commands instructing the coupled printing device to print a product coupon. The advantage of

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this modification would be to provide high relevance feedback to advertisers when this coupon is used.

35. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Logan in further view of Yoda (5,515,268). Dubbels in view of Logan discloses the invention as stated in claim 28. The combination does not disclose the controller issuing a request to a product warehouse causing a product subsidy to be sent to the user. However the combination does disclose sending the user a subsidy as described above. And Yoda teaches, in lines 18-23 of column 3, sending a user a product from a warehouse. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the controller to issue a request to a product warehouse causing a product subsidy to be sent to the user. This would allow the provider to not have to have all the products stored locally.

36. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Herz. Dubbels discloses the invention as stated in claim 18. Dubbels does not disclose the apparatus of claim 18, wherein the local memory further comprises a user profile, wherein the controller updates the user profile with at least information regarding document requests. Herz teaches, in lines 48-53 of column 6, constructing a "target profile interest summary for each user" which is equivalent to a user profile. Herz further discloses, in lines 30-32 of column 5, that "users' target profile interest summaries are automatically updated on a continuing basis to reflect each user's changing interests". This is equivalent to updating the user profile with information regarding document requests. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the local memory of Dubbels to further comprise a user profile, wherein the controller updates the user profile with at least information regarding

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document requests. The advantage of this modification would be to efficiently organize the distribution of information in a large scale system consisting of many users interconnected by means of a communication network.

37. Claims 15, 31 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dubbels in view of Griebenow, *et al.* (5,850,520). With regard to claim 15, Dubbels discloses the invention as stated in claim 1. Dubbels does not disclose prompting the user as to whether they wish to add the requested documents to an automated periodic printing schedule and periodically printing requested documents identified in the periodic printing schedule.

Griebenow teaches, in lines 25-31 of column 4, creating a print schedule and periodically printing documents that a user has requested for periodic printing. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the method of Dubbels to prompt the user as to whether they wish to add the requested documents to an automated periodic printing schedule and periodically print requested documents identified in the periodic printing schedule. This would allow users to receive periodicals in a convenient electronic format.

38. With regard to claim 31, Dubbels discloses the invention as stated in claim 18. Dubbels does not disclose prompting the user with an offer to add the requested documents to an automated print delivery schedule. Griebenow teaches, in lines 25-31 of column 4, adding documents ordered by a user to an automatic print delivery schedule. It would have been obvious to one of ordinary skill in the art at the time the invention was made to prompt the user with an offer to add the requested documents to an automated print delivery schedule. This would allow users to receive periodicals in a convenient electronic format.

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39. With regard to claim 40, Dubbels discloses the invention as stated in claim 36. Dubbels does not disclose tertiary iconic selectors, associated with a document, to add the document to an automated printing delivery schedule. Dubbels does tertiary iconic selectors (print button, column 5, line 32). Griebenow teaches, in lines 25-31 of column 4, adding documents ordered by a user to an automatic print delivery schedule. It would have been obvious to one of ordinary skill in the art at the time the invention was made for the GUI of Dubbels to comprise tertiary iconic selectors, associated with a document, to add the document to an automated printing delivery schedule. This would allow users to receive periodicals in a convenient electronic format.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Foster whose telephone number is (703)305-1900. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

JF



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